

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

020375-022010US

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on November 4, 2008.

TOWNSEND and TOWNSEND and CREW LLP

Signature /Joni E. Peterson/Typed of printed name Joni E. Peterson

Application Number

10/025,092

Filed

December 19, 2001

First Named Inventor

Lynn Holm-Blagg

Art Unit

3691

Examiner

Olabode Akintola

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor./William J. Daley/☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

William J. Daley

Typed or printed name

☒ attorney or agent of record.
Registration number 52,471(303) 571-4000

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____November 4, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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TOWNSEND and TOWNSEND and CREW LLP

By: /Joni E. Peterson/
Joni E. Peterson

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

PATENT
Attorney Docket No.: 020375-022010US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Lynn Holm-Blagg et al.

Application No.: 10/025,092

Filed: December 19, 2001

For: FINANCIAL TRANSACTION
ACCOUNT USAGE PARAMETER
ACCESS AND CONTROL METHOD

Customer No.: 20350

Confirmation No.: 5079

Examiner: Olabode Akintola

Technology Center/Art Unit: 3691

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

***Via EFS-Web
Mail Stop AF***
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of the Pre-Appeal Brief Request for Review, that is submitted herewith. The applicants respectfully request review of the final rejection mailed by the U.S. Patent Office for the above-identified application on August 5, 2008 ("the Final Office Action").

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

The final Office Action rejected claims 1-11 and 35 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; rejected claims 1-4, and 7-10 under 35 U.S.C. § 102(e) as being anticipated by U. S. Patent No. 6,636,833 to Flitcroft et al. (hereinafter "Flitcroft"); rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Flitcroft as applied to claim 3 in view of U. S. Patent No. 6,327,573 to Walker et al. (hereinafter "Walker"); and rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Flitcroft as applied to claim 3 in view of U. S. Patent No. 5,826,243 to Musmanno et al. (hereinafter "Musmanno"). .

2. Reasons for Requesting Review

35 U.S.C. § 112 Claim Rejections

The final Office Action rejected claims 1-11 and 35 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the final Office Action rejects claim 1 alleging that the recitation of "wherein the *credit product* is different from the second credit product" is not clear as to which of the credit products "credit product" refers to. An amendment has been made in the response filed October 2, 2008 that is thought to fully address the reasons for the rejection. Specifically, the phrase "wherein the *credit product* is different . . ." was amended to recite "wherein the *first credit product* is different . . ." The Advisory Action did not indicate whether this amendment was entered. This amendment was made only to correct a formal matter and is thought to add no new matter. Therefore, the Applicants respectfully request entry of the amendment and withdrawal of the rejections.

35 U.S.C. § 102 Rejection, Flitcroft

The final Office Action rejected claims 1-4, and 7-10 under 35 U.S.C. § 102(e) as being anticipated by U. S. Patent No. 6,636,833 to Flitcroft et al. (hereinafter "Flitcroft"). The Applicant respectfully submits the following arguments pointing out significant differences between claims 1-4, and 7-10 submitted by the Applicants and Flitcroft.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully argue that Flitcroft fails to disclose each and every claimed element. For example, Flitcroft fails to disclose, either expressly or inherently, multiple accounts as recited in claim 1.

As noted previously, Flitcroft is directed to "a credit card system and method offering reduced potential of credit card number misuse." (Col. 1, lines 19-21) More specifically, Flitcroft discloses "maintaining a pool of credit card numbers which share identical formatting; assigning at least one credit card number from the pool of credit card numbers to be a master credit card number; assigning at least one credit card number from the pool of credit card numbers to be a limited-use credit card number which is deactivated upon a use-triggered condition subsequent; and associating the master credit card number with the limited-use credit card number, while ensuring that the master credit card number cannot be discovered on the basis of the limited-use credit card number." (Col. 4, line 61 - col. 5, line 4) That is, Flitcroft discloses assigning limited use numbers to an account that can be used as proxies or aliases for the real number of the account (the "master number").

However, Flitcroft does not disclose, expressly or inherently, more than one account. Rather, Flitcroft discloses only one master account having a number of different limited use account numbers. For example, FIG. 7 of Flitcroft and the accompanying description found at col. 25, lines 1-63 describe a process for processing a transaction in which a limited use number is used to look up an associated master account number which is then passed to the processing system (see specifically col. 25, lines 15-18). Furthermore, Flitcroft does not disclose a first account of a first credit product and a second account of a second credit product different from the first credit product, e.g., a MasterCard account and a Visa account. The Applicants note that the final Office Action cites col. 6, lines 32-49 as allegedly disclosing a first account of a first credit product and a second account of a second credit product different from the first credit product. However, rather than disclosing a first account of a first credit product and a

second account of a second credit product different from the first credit product, this section of Flitcroft seems to be a general definition of the term credit card as used in the description.

Furthermore, the paragraph containing the cited section goes on to note:

"It will be appreciated that an account may have many master credit cards in the sense of this specification. For example a corporation may provide many of its employees with credit cards but essentially each of these employees holds a master credit card even if there is only one customer account. Each of these master credit cards will have a unique master credit card number, which set of master credit card numbers will be linked to the account. Similarly, in families, various members of the family may hold a master credit card all of which are paid for out of the one customer account." (Col. 6, lines 43-52, emphasis added)

Thus, Flitcroft specifically discloses only one account, not a first account of a first credit product and a second account of a second credit product different from the first credit product.

In response to these arguments, the final Office Action points to col. 6, lines 32-53 which generally recite that different types of cards may be issued. However, the citation and the argument of the Office Action stops short of addressing the immediately following portion of Flitcroft quoted above, namely, col. 6, lines 43-52 which point out that while multiple cards may be issued, the customer has only one account to which these cards are linked. Thus, the Applicants respectfully maintain that Flitcroft discloses only one master account having a number of different limited use account numbers.

The final Office then goes on to contend that "there is no functional relationship between the second account and the other steps in the claim." The Applicants respectfully direct attention to claims 2 and 3, for example.

Claim 1, upon which claims 2-4, 7-11, 35, and 36 depend, recites in part "establishing a first credit card account of a first credit product with a holder of the first account; establishing a second credit card account of a second credit product with a holder of the second account wherein the credit product is different from the second credit product." Flitcroft does not disclose, expressly or inherently, a first account of a first credit product and a second account of a second credit product different from the first credit product. Rather, Flitcroft describes only one account which may have a number of associated limited use numbers that are used as aliases

for the master account number. For at least these reasons, the rejection should be withdrawn and claims 1-4, 7-11, 35, and 36 should be allowed.

35 U.S.C. § 103 Rejection, Flitcroft in view of Walker

The final Office Action has rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Flitcroft as applied to claim 3 in view of U. S. Patent No. 6,327,573 to Walker et al. (hereinafter "Walker"). The Applicants respectfully requests withdrawal of the rejection and allowance of the claim for at least the reason that claim 11 depends upon claim 1 that is thought to be allowable as described in detail above.

35 U.S.C. § 103 Rejection, Flitcroft in view of Musmanno

The final Office Action has rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Flitcroft as applied to claim 3 in view of U. S. Patent No. 5,826,243 to Musmanno at al. (hereinafter "Musmanno"). The Applicants respectfully requests withdrawal of the rejection and allowance of the claim for at least the reason that claim 35 depends upon claim 1 that is thought to be allowable as described in detail above.

For at least these reasons, the Applicants maintain that the rejection is improper and should be withdrawn.

Respectfully submitted,

Date: November 4, 2008

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